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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/623,933

07/21/2003

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6471

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10/03/2007

EXAMINER

SMALLEY, JAMES N

ART UNIT

PAPER NUMBER

3781

MAIL DATE

DELIVERY MODE

10/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/623,933

Applicant(s)

SMITH, JAMES C.

Examiner

James N. Smalley

Art Unit

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-23 and 47-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-23 and 47-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly amended claim 18 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The amendment to the claim to draw the claim to the combination of the pipette apparatus broadens the scope of the claim beyond that which was originally presented.

Since applicant has received an action on the merits for the originally presented invention, i.e. the wiping cap device only, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 18 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Examiner notes this can be overcome by amending the claim to remove the amendment "A pipetting apparatus for transferring an internal calibrated volume of fluid having" from the claim, in order to return the claim to the original scope. Examiner will furthermore treat the claim as though the amendment was not made, assuming the scope is just to the wiping cap device as previously presented.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

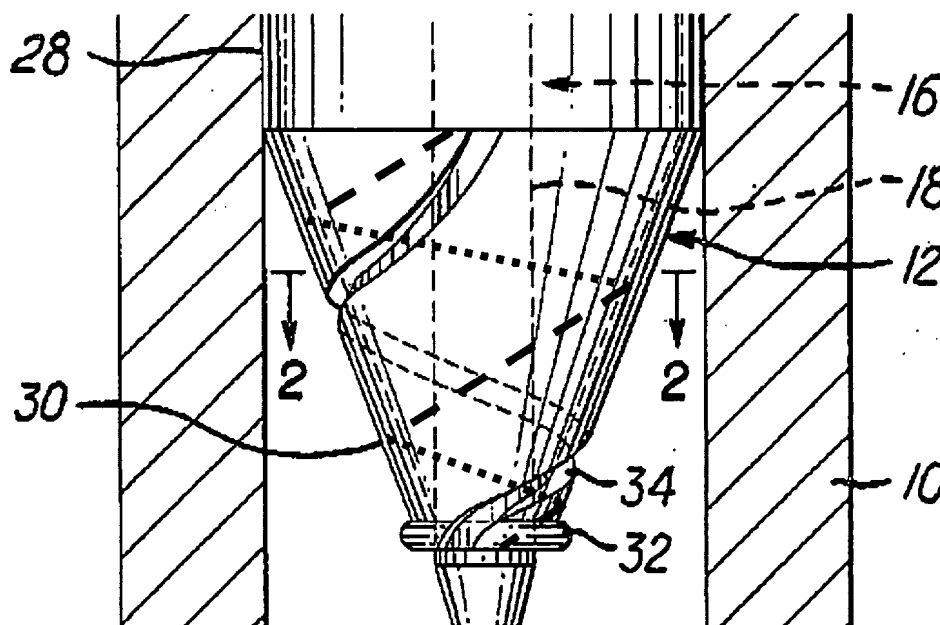
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 18 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Carluccio US 4,390,298.

Carluccio '298 teaches a tubular member (10) having an open end, and a wiping cap (12) including a cup-shaped conical wiper, and a frustum (26) for mating with the tubular member. Examiner notes the wiper forms a seal at the apex around the applicator head (22), which alternatively can be read as forming a substantial seal because it tapers to a narrow opening. Also, Examiner notes the wiper appears to make more than one full revolution. See the dotted lines below whereby it appears the wiper

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actually makes almost two revolutions. Examiner notes the dashed line represents the frontal path, and the dotted line is the path as it is traced behind the cone. Also, note the very bottom of the line is difficult to see, but can be seen adjacent the line for element (32). Finally, Examiner notes the spiral cut (34) appears to make one full revolution. It is suggested the Applicant amend the claim to better define the structural differences over Carluccio '298 in view of this analysis.



Examiner notes the figure provided above, whereby the dotted lines drawn by Examiner make a complete circumferential loop around the brush, and therefore are in complete circumferential contact. Examiner furthermore notes Applicant's own figures 16-17, whereby it can be seen the pipette is not in complete contact with the entire wiper, only a portion of it, and that Carluccio '298 would appear to function in a similar manner.

Examiner notes the phrase "squeegee like" is read to compare to a squeegee which wipes liquid from a surface using a resilient edge, such is rubber. In the instant case, the conical wiper of Carluccio

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'298 is taught in column 1, line 41, to be formed of a resilient material, and thus it would appear to remove liquid in a "squeegee like" means.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 18-23 and 47-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith US 5,513,768 in view of Carluccio US 4,390,298 and in view of Leopardi et al. US 5,514,339.

Smith '768 teaches a cap for a container (12) comprising a locking cap (16) and a sealing cap (14) with a syringe port (54) and sealing frustum (27). The embodiment of figure 6 teaches the locking cap and syringe cap being connected to the container by hinges (22) and (38). The embodiment of figure 13B teaches a threaded connection (188).

Smith '768 does not teach a wiping feature.

Leopardi '339, column 4, lines 13-20, teaches it is desirable to provide a wiping feature to remove excess liquid, such as blood, from the syringe (43).

Carluccio '298 teaches it is known to provide a wiping feature in the form of a conical wiper (30) with a helical slot (34). Although disclosed for a brush applicator, the device is inherently capable of wiping a syringe.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cap of Smith '768, providing a wiping feature comprising a conical wiper with a helical slot on the cap (14) as this is the portion of the cap to be punctured by the pipette tip, as taught by Carluccio '298, and taught to be a desirable addition to a syringe port by Leopardi '339, motivated by the benefit of removing excess liquid such as blood, from a syringe.

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Examiner notes the figure provided above, whereby the dotted lines drawn by Examiner make a complete circumferential loop around the brush, and therefore are in complete circumferential contact. Examiner furthermore notes Applicant's own figures 16-17, whereby it can be seen the pipette is not in complete contact with the entire wiper, only a portion of it, and that Carluccio '298 would appear to function in a similar manner.

Examiner notes the phrase "squeegee like" is read to compare to a squeegee which wipes liquid from a surface using a resilient edge, such is rubber. In the instant case, the conical wiper of Carluccio '298 is taught in column 1, line 41, to be formed of a resilient material, and thus it would appear to remove liquid in a "squeegee like" means.

#### ***Response to Arguments***

6. Applicant's arguments filed 31 October 2006 have been fully considered but they are not persuasive.

Examiner notes the reply to Applicants arguments in support of the amendments herein have been clearly addressed in the rejections, and in the figure provided above.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N. Smalley whose telephone number is (571) 272-4547. The examiner can normally be reached on Monday - Friday 10 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jns

 9/26/2007

  
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